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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,884	11/17/2003	Colin Waters	16793-002001	5282
20985	7590	02/23/2005	EXAMINER	
FISH & RICHARDSON, PC 12390 EL CAMINO REAL SAN DIEGO, CA 92130-2081			TA, THO DAC	
			ART UNIT	PAPER NUMBER
			2833	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/715,884

Applicant(s)

WATERS ET AL.

Examiner

Tho D. Ta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 and 9 is/are allowed.
- 6) ☒ Claim(s) 2-6, 8 and 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "said lower voltage" in line 10. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 2-4, 6, 8, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lindeberg et al. (5,178,561).

In regard to claims 2, 3, Lindeberg et al. discloses a method, comprising: marking a first portion (left side of Fig. 3) of a first connector 10 used to supply a first type of electricity, by blocking one of the pins of the first connector 10; marking a corresponding location of a second connector (mating connector is not shown, it is inherent) which mates with the first connector 10, but is used with a

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second type of electricity, which is incompatible with the first type of electricity, by forming a protruding portion (the pin contact from the mating connector) in a corresponding area to the blocked location 7, thereby preventing the second connector used for the second type of electricity from being inserted into the first connector 10 used for the first type of electricity.

The recitations regarding voltage have not been given significant patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In regard to claim 4, Lindeberg et al. discloses that each of the first and second connectors have a plurality of pins, and where the first connector 10 is a female connector and the second connector is a male connector.

In regard to claim 6, Lindeberg et al. discloses that each of the first and second connectors have a spare pin (7 for first connector 10) which is not used for electrical connection, and the first portion 2 of the first connector 10 and the corresponding portion (the contact of the mating connector) of the second connector use an area of the spare pin (see fig. 3).

In regard to claim 8, the recitations regarding voltage have not been given significant patentable weight because it has been held that a recitation with

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respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In regard to claim 10, Lindeberg et al. discloses that marking a first portion of a third connector (which is the connector 10 when insulating plus 1 and 3 are used) used to supply a lower voltage with a corresponding female pin, which mates with the protruding portion (the pin contact from the mating connector). The recitation regarding voltage has not been given significant patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

5. Claims 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hubbell (3,120,985).

In regard to claim 11, Hubbell discloses a method, comprising: forming a first version of a first connector 1 intended for use with a higher voltage, having a specified portion which is blocked (when 44 is blocked); forming a second version of the first connector 1 (when 44 is not blocked, see fig. 1), intended for use with a lower voltage, having the specified portion 44 which is open; and forming a first version of a second connector 25 that mates with the second version of the first connector 1, and is intended for use with the lower voltage,

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and which has a portion 48 that protrudes by a length longer than any other protruding portions in the first version of the second connector 25 (see fig. 8) in a location corresponding to the specified portion which is blocked.

In regard to claim 12, Hubbell discloses forming a second version of the second connector 25 that is intended for use with the higher voltage, and does not have the protruding portion 48 (this is inherent since 48 is a removable key).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lindeberg et al..

In regard to claim 5, Lindeberg et al. does not disclose that each of the first and the second connectors having 19 pins. It would have been obvious to add more pins to each of the first and the second connectors, while the additional pins undoubtedly made it versatile, such a modification would have involved a mere change in the number of the parts. Duplication of parts for a multiplied effect is generally recognized as being within the level of ordinary skill in the art. *St Regis Paper Co. V. Bemis Co., Inc.*, 193 USPQ 8, 11 (7<sup>th</sup> Cir. 1977).

***Allowable Subject Matter***

8. Claims 7 and 9 are allowed.

***Response to Arguments***

9. Applicant's arguments with respect to claims 11 and 12 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments filed 11/29/04 have been fully considered but they are not persuasive.

In response to applicants' argument that Lindeberg et al. does not teach or suggest that different kinds of electricity be used. First of all, one of ordinary skill in the art would recognize that the purpose of using the key in the connector is to prevent the mating of the two connectors having different applications. Secondly, since Lindeberg et al. discloses an electrical contact, thus one of ordinary skill in the art would recognize that Lindeberg et al. intends to prevent the mating of the two connectors having different electrical voltages or currents.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory


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action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tho D. Ta whose telephone number is (571) 272-2014. The examiner can normally be reached on M-F (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (571) 272-2800 ext 33. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tdt  
02/21/05

  
THO D. TA  
PRIMARY EXAMINER